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In the Supreme Court of the United States

OCTOBER TERM, 1958

JEROME S. SPEVACK, PETITIONER

v.

LEWIS L. STRAUSS, ET AL.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

BRIEF FOR THE RESPONDENTS IN OPPOSITION

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OPINIONS BELOW

The opinion of the United States Court of Appeals for the District of Columbia Circuit, dated June 9, 1958 (Pet. 14a–16a), is reported at 257 F. 2d 208. Earlier opinions rendered in this litigation are reported at 248 F. 2d 752 and 355 U. S. 601.

JURISDICTION

The judgment of the Court of Appeals was entered on June 9, 1958 (Pet. 16a). Petitioner's "suggestion" filed on June 11, 1958, that the Court of Appeals *sua sponte* vacate its opinion was denied on June 24, 1958. The petition for a writ of certiorari was filed

on September 6, 1958. The jurisdiction of the Court is invoked under 28 U. S. C. 1254 (1).

QUESTIONS PRESENTED

1. Petitioner's avowed purpose in this suit is to obtain time in which to file patent applications abroad. Since the declassification by the Atomic Energy Commission of information dealing with heavy water technology on or about February 1, 1957, and the concurrent lifting of the secrecy order on petitioner's now pending application before the United States Patent Office, petitioner has had 21 months in which to accomplish this objective, a considerably longer period than that which would have been his right under the Convention for the Protection of Industrial Property. In these circumstances, the question presented is whether petitioner can continue to demand equitable assistance to prevent the dissemination of information with regard to heavy water technology, particularly in view of the fact that there is an overriding public interest in the dissemination of such information of which petitioner's process forms only a small part.

2. Whether, in the particular circumstances of this case, the Atomic Energy Commission had authority to divulge data relating to petitioner's alleged invention and whether petitioner can obtain just compensation (if he is entitled to it).

CONVENTION AND STATUTES INVOLVED

The pertinent provisions of the Convention for the Protection of Industrial Property of June 2, 1934 (53

Stat. 1768), of the Atomic Energy Act of 1954 (68 Stat. 919), and of Title 35 of the United States Code (Patents) are set forth in the Appendix, *infra*, pp. 25–27.

STATEMENT

1. *The factual background.* (*a*). From 1943 to 1946, petitioner was employed by a contractor of the Manhattan Engineering District, the predecessor to the Atomic Energy Commission. During this period, he invented a dual temperature exchange process for the production of heavy water.[1] A patent application on this process was held in abeyance under 35 U. S. C. 181 while the invention was held classified. It was issued to the Atomic Energy Commission as petitioner's assignee (R. 2) in April 2, 1957, after the secrecy order had been rescinded.

Between 1946 and 1949, while self-employed, petitioner developed what he considers a new and improved process for the production of heavy water. In October 1949, petitioner was hired by contract with the Atomic Energy Commission as a paid consultant. In this capacity he prepared and submitted a report analyzing the dual temperature process for the production of heavy water including his alleged improvements. Petitioner reserved, however, any invention rights in his alleged new process (R. 46-49, Pet. 16).

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[1] For the important role played by heavy water in the production of special nuclear materials, see *e. g.*, Smyth, *A General Account of the Development of Methods of Using Atomic Energy for Military Purposes Under the Auspice of the United States Government, 1940–1945*, pp. 22–23, 47–48, 122–123.

A patent application on this alleged invention was filed on September 29, 1950 (R. 9). On October 30, 1950, the Patent Office, acting under the authority of the Act of October 6, 1917, 40 Stat. 394, as amended, now 35 U. S. C. 181, issued a secrecy order with respect to that application. Pursuant to this order the grant of the patent was withheld and petitioner was enjoined from the publishing and disclosing of the invention (R. 9–10). While the secrecy order was effective petitioner was prevented from filing patent applications in foreign countries (R. 3–4) and did not have available the protection of Article 4 of the Convention for the Protection of Industrial Property (*infra*, pp. 25–26) which provides that if a patent has been filed in a convention state [2] it may be filed within a year in any other state belonging to the convention without being open to the challenge of prior publication.[3]

(*b*). In the 1950's, the United States built several plants for the production of heavy water. Manuals and reports were prepared describing the operation of the plants and the processes used in them. Petitioner claims that one or more of these heavy water plants utilize the improved process described in his 1949 report and the subject matter of his 1950 patent

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[2] The United States and some fifty other countries are members of the Convention. *Treaties in Force, a List of Treaties and Other International Agreements of the United States, in Force on January 1, 1958*, p. 209.

[3] In some countries the grant of a United States patent amounts to a publication (R. 13).

application, and that the manuals and reports disclose his invention.[4]

Late in 1956, the Atomic Energy Commission determined that defense and security considerations no longer required the classification of the processes for the production of heavy water and that, thenceforth, this information should be disseminated.[5] Specifically, it was to have been discussed at a conference on isotope separation processes to be held in Amsterdam in April 1957 (cf. Pet. 17a). The Commission published a notice in December 1956 that it proposed to declassify heavy water information. On January 22, 1957, petitioner wrote to the Chairman of the Commission, requesting declassification of the subject matter of his two patent applications (*supra*, pp. 3–4), as he desired to deliver a paper concerning them at the Amsterdam conference (R. 50).

In the early part of 1957, the Atomic Energy Commission was declassifying the technical data on heavy water production (R. 4). It made available to the public the manuals and reports describing the operation of heavy water plants (R. 19–37) and opened

[4] R. 48–49. See also Petitioner's Petition for Discovery filed in this Court on August 25, 1958, pp. 3, 6, Exh. 4, 6; and R. 19–37.

In order to simplify the presentation of the facts and the legal discussion, we shall assume in the remainder of this brief, without, however, conceding it, that petitioner's "new" process constitutes a substantial improvement over the prior art (Cf. R. 42–48), that it was used in the heavy water plants constructed by the Atomic Energy Commission, and that the manuals and reports refer to it.

[5] Cf. Secs. 141, 142 of the Atomic Energy Act, *infra*, pp. 26–27.

the plants to public inspection. The secrecy orders relating to petitioner's inventions were rescinded on February 1, 1957 (R. 4).

(*c*). At this juncture, petitioner apparently changed his mind and requested the Atomic Energy Commission to refrain from the publication of any data relating to his 1950 patent application in view of the adverse effect such publication would have on the patentability of the invention in foreign countries. Petitioner pointed out that, as the result of the secrecy order, he had not been able to file his foreign patent applications within the one-year period allowed by the Convention for the Protection of Industrial Property. In a letter addressed by his patent attorney to the Atomic Energy Commission on March 13, 1957, and incorporated in his complaint (R. 11-13), he took the position that, while he was proceeding "as rapidly as possible" with the filing of patent applications in a number of foreign countries, it

> * * * would be most unfair for the Commission * * * to publish information that would bar a U. S. citizen from obtaining foreign patents on applications that could not previously be filed because of secrecy orders instigated by the Commission.
>
> * * * * *
>
> Of course *when Mr. Spevack's U. S. patent is issued and this itself becomes a publication, a matter that we hope will ensue within the next few months,* then anything disclosed * * * at that time will not be a breach of any contractual or moral duty owed to Mr. Spevack by

> the Commission as a branch of the Government dealing fairly with its citizens. [Emphasis added.]

On March 21, 1957, the respondents advised petitioner to the effect that they were willing to postpose by thirty days the publication of the two reports specified in petitioner's letter of March 13, 1957 (cf. R. 13, footnote), and to consider a similar delay with respect to such other Commission reports as petitioner would request. The thirty-day period would have expired approximately at the time of the opening of the Amsterdam conference (*supra*, p. 5), at which Mr. Spevack had planned to describe the entire processes. At that time, therefore, the withholding of those reports and any others he desired to identify would not interfere with petitioner's de[illegible] nor with the statutory duties of the Commission to permit and encourage "The dissemination of scientific and technical information relating to atomic energy * * * so as to provide that free interchange of ideas and criticism which is essential to scientific and industrial progress" (Atomic Energy Act, Section 141, 68 Stat. 940, 42 U. S. C. (Supp. V) 2161).

2. *The judicial proceeding.* On April 10, 1957, petitioner filed his complaint for injunctive relief (R. 1–13). The basic theory of the complaint is that, as the result of the 1950 secrecy order, petitioner was deprived of the benefits of the Convention for the Protection of Industrial Property (*supra*, p. 4), *viz.*, that, if he could have filed his patent applications abroad within a year of the filing of his application with the United States Patent Office,

these foreign applications could not have been dedicated by the publication of his patent during that year. Petitioner, therefore, asked that the publication of information with regard to his process be enjoined lest he be barred from obtaining patents abroad. He assured the court that he was taking steps to file patent applications in 21 foreign countries as rapidly as possible (Complaint, par. 15, R. 6).

On the same day, April 10, 1957, petitioner obtained a temporary restraining order on the ground that "the disclosure of the subject matter of plaintiff's U. S. Patent Application, Ser. No. 188,925, prior to his application for foreign patents * * * would be to destroy plaintiff's right to obtain foreign patents on his said invention in most foreign countries * * *" (R. 14–15). The order enjoined respondents from "causing or permitting the dissemination of any documents, reports, memoranda, technical data, in their pleadings in this action,[6] or otherwise, disclosing the heretofore unpublished features of plaintiff's [petitioner's] Patent Application * * *."

Petitioner's motion for a preliminary injunction was opposed on the ground that the litigation had become moot as the result of the publication of the pertinent information before the litigation had commenced. Affidavits attached to respondents' opposition to the motion for preliminary injunction indicated the extent of the disclosure (R. 17, 19–37).[7]

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[6] This feature of the temporary restraining order has prevented the making of a record which adequately describes the nature of the controversy.

[7] The secrecy had been lifted on or about February 1, 1957. By February 6, 1957, the manuals and reports started to

The District Court denied the motion for a preliminary injunction on the ground that the litigation had become moot because some reports containing a description of the alleged improvements claimed by petitioner had been available to the public before the suit had been filed (R. 18).

The Court of Appeals affirmed. It held that respondents possessed the statutory authority to disclose the data here involved and that petitioner, at best, challenged respondents' discretion in exercising that power; hence, that the complaint actually constituted an unconsented suit against the United States which should have been dismissed for lack of jurisdiction, rather than on the ground of mootness. In these circumstances the Court of Appeals did not reach the latter issue (Pet. 9a–11a).

The judgment of the Court of Appeals was entered on September 19, 1957 (Pet. 9a). Twelve days later, petitioner applied for leave to amend the complaint so as to include allegations to the effect that respondents lack authority to publish any data relating to an invention not owned by the United States without the consent of the inventor or, in the alternative, that the statute would be unconstitutional if it purported to have such effect (Pet. 12a–14a). The Court of Appeals denied the motion to amend the complaint, and also denied a motion for a rehearing filed on October 4, 1957 (Pet. 19–20).

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become available to the public (R. 19, 20). Petitioner instituted these proceedings on April 10, 1957, *i. e.*, nearly two months later (Pet. 18).

Upon petition for a writ of certiorari, this Court granted the writ and remanded the cause to the Court of Appeals with instructions to allow the proposed amendments, and to determine the issues raised by petitioner's appeal in the light of the amendment (355 U. S. 601). On remand, the Court of Appeals adhered to its earlier decision (Pet. 14a–16a). It held that it had determined in that decision that the Atomic Energy Act authorized "this sort of publication," *i. e.*, the dissemination in these circumstances of scientific and technical information relating to atomic energy whether or not the process was owned by the United States. Relying on the decisions of this Court in *Yearsley* v. *Ross Construction Co.*, 309 U. S. 18, 21; *United States* v. *Causby*, 328 U. S. 256; and *Larson* v. *Domestic and Foreign Corp.*, 337 U. S. 682, 697, fn. 18, the Court of Appeals held that this interpretation of the statute did not render the latter unconstitutional. If the publication constituted the taking of the property right of an inventor, the United States had promised either expressly or by implication to pay just compensation to the owner and afforded to him a remedy for its recovery in the Court of Claims; the availability of this judicial remedy fully satisfied the requirements of the Fifth Amendment which does not command the payment of damages by the United States prior to the taking.

3. *The present status of petitioner's patent application and the effect of the restraint upon respondents.* (*a*). The District Court denied petitioner's preliminary restraining order on April 19, 1957, *i. e.*,

nearly 18 months ago. As a result of a series of stay orders and injunctions issued by this Court and by the Court of Appeals, respondents are still, in substance, subject to the prohibition of the original temporary restraining order (cf. Pet. 19–23). Since the latter was issued in order to enable petitioner to file some twenty-one patent applications abroad during the few months in which the patent was expected to issue (*supra*, pp. 7–8), information about the present status of petitioner's domestic and foreign patent applications would be most appropriate. The petition for a writ of certiorari is silent on the latter issue. According to an affidavit filed by petitioner in the Court of Appeals on April 16, 1958, *i. e.*, after the respondents' restraint had been in effect for about a year, he had by then filed patent applications in twelve countries and was in the process of applying for a patent in a thirteenth one; he also desired "to file patent application for the subject matter here involved in as many of the 108 patent-issuing countries[8] of the world as is prudently possible and within his means." We do not know what progress petitioner has made during the past five and a half months.

The petition for certiorari discloses that all the claims of petitioner's patent have now been allowed

[8] According to the complaint, petitioner contemplated the filing of patents in twenty-one countries "and in other countries in which it may be determined that commercial use of the invention is likely" (R. 6). The Convention for the Protection of Industrial Property is in effect in some 50 countries (*supra*, p. 4, fn. 2).

by the United States Patent Office (Pet. 17).[9] A patent, accordingly, may issue shortly after petitioner pays the final filing fee which, in most instances, amounts to $30 (35 U. S. C. 41 (a) (2)).[10]

(*b*). The effect of the restraint upon respondents has been very substantial. In order to comply with the temporary restraining order of April 11, 1957, respondents examined about 1,000 reports and similar documents in order to determine whether they contained any reference to the claims specified in petitioner's patent application (cf. R. 15). As a result, some forty declassified documents had to be impounded again in their entirety because they contained possibly some reference to petitioner's patent claim.[11] Similarly, access to heavy water plants which had been opened to inspection by scientists and technicians, as well as other interested persons, had to be denied again because they contained some features which possibly were covered by petitioner's patent claim.

In addition, the restraining order and the injunctions keeping it in effect have had a profound effect upon the participation by the respondents in the dis-

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[9] See also the Petition for Discovery filed on August 25, 1958, pp. 3–4, and Supplement to Petition for Discovery filed on September 12, 1958, p. 2.

[10] According to 35 U. S. C. 151, a patent issues within three months after payment of the final fee which, in turn, is payable not later than six months after the applicant has been notified of the allowance of his claim.

[11] In the report referred to at R. 31, less than 25 percent of the pages refer to petitioner's invention. In the remaining documents, the proportion is smaller.

cussion and dissemination of information in the entire field of heavy water production. In particular it has greatly limited the participation of the United States in two international conferences called under the Atoms for Peace programs, *viz.*, the Amsterdam Conference of April 1957 and the Second International Scientific Conference on the Peaceful Uses of Atomic Energy held in Geneva, Switzerland, during the first two weeks of September 1958. It also places restrictions on the ability of the United States to cooperate with the Organization for European Economic Cooperation, of which the United States is an associate, in its current studies of methods of constructing heavy water plants (Pet. 17a–19a).

ARGUMENT

Petitioner asserts that this case involves the very general and broad proposition of whether the Atomic Energy Commission has authority to publish a pending patent application or an invention submitted to it pursuant to the requirements of Section 151 (c) of the Atomic Energy Act (68 Stat. 943, 42 U. S. C. (Supp. V) 2181 (c)).[12] The *amici curiae* similarly urge that the Court pass on this broad issue. Respondents, however, do not seek to publish petitioner's alleged invention as such. They seek to make avail-

[12] Section 151 (c) of the Atomic Energy Act requires the inventor of certain types of inventions to file with the Atomic Energy Commission a complete report thereof, unless a description is contained in a patent application. Since petitioner has filed a patent application for invention, Section 151 (c) is inapplicable to this case.

able, to the scientific and technological community at large, information concerning the operation of Commission-owned heavy water plants. The disclosure of petitioner's alleged invention is at most an incident of the publication of a large mass of government-owned scientific and technological knowledge. Moreover, respondents learned of petitioner's process not by inspection of confidential files, but by virtue of a report which petitioner prepared for them as a paid consultant. In these circumstances, petitioner's reservation of any invention rights (Pet. 16) could do no more than preserve his claim to monetary compensation. He cannot demand that all information relating to the government-owned plants and processes used in their operation be kept secret—contrary to the policy of the Atomic Energy Act—while he files patent applications *seriatim* in 108 countries. In any event, petitioner is at most entitled to a year's protection to compensate him for the loss of the twelve months' filing period under the International Convention for the Protection of Industrial Property. The year has long expired.

I

Petitioner seeks to enjoin the publication of a mass of information relating to the production of heavy water. The dissemination of that data and its availability for public inspection is in the public interest. The continuation of the veil of secrecy interferes with the various programs of the Atomic Energy Commission (*supra,* pp. 12–13). Moreover, the vast majority of the data is owned by the United States. Respondents have every right to make it available

to the public; indeed, respondents have the statutory duty to do so under Section 141 of the Atomic Energy Act (68 Stat. 940, 42 U. S. C. 2161 (b)) which provides that:

> The dissemination of scientific and technical information relating to atomic energy should be permitted and encouraged so as to provide that free interchange of ideas and criticism which is essential to scientific and industrial progress and public understanding and to enlarge the fund of technical information.

Petitioner's interest in the continued sequestration of this fund of knowledge is that a small portion thereof represents an invention of his and that publication would jeopardize his ability to obtain patents abroad. The precise question thus is whether petitioner's interest in keeping secret a small part of a large complex of information, the remainder of which may be and should be made available to the scientific and industrial community, entitles him to a judicial decree enjoining indefinitely the publication of the whole; in other words, whether a large public interest must yield to a proportionally much smaller private one. In our view, the answer must be in the negative in the circumstances of this case.

1. It is a basic tenet of equity jurisprudence that the mere invasion of a right does not entitle a litigant to injunctive relief. That remedy does not issue as of course; it is awarded only in the exercise of sound judicial discretion on the basis of equitable principles. *Harrisonville* v. *Dickey Clay Co.*, 289 U. S. 334, 337–338; cf. *Duncan Townsite Co.* v. *Lane*, 245 U. S. 308,

311-312; *United States* v. *Dern*, 289 U. S. 352, 360-361. One of the principal considerations determining whether or not injunctive relief should be granted is the balancing of the relative equities of the parties, a consideration which is of especial importance where, as here, a private interest is confronted with a large public exigency. *Harrisonville* v. *Dickey Clay Co., supra; Morton Salt Co.* v. *Suppiger Co.*, 314 U. S. 488, 493, and the authorities there cited. As this Court has pointed out, "[t]he history of equity jurisdiction is the history of regard for public consequences in employing the extraordinary remedy of the injunction" *Railroad Commission* v. *Pullman Co.*, 312 U. S. 496, 500. A different formulation of the same idea is the ruling that "[c]ourts of equity may, and frequently do, go much farther both to give and withhold relief in furtherance of the public interest than they are accustomed to go when only private interests are involved." *Virginian Ry.* v. *System Federation No. 40*, 300 U. S. 515, 552.

2. Here, we submit, the congressional finding (*supra*, p. 15) of the public interest in the dissemination of non-classified information relating to atomic energy goes far to outweigh petitioner's interests in prolonging the period during which his invention must be kept secret, particularly in view of the special circumstance of the case. The reasons for denying the injunction—in any event at the present time—are compelling, cf. *Harrisonville* v. *Dickey Clay Co., supra.*

(*a*). The complaint itself indicates that petitioner no longer is entitled to injunctive relief. The com-

plaint (R. 1–13) rests on the theory that petitioner needs an injunction in order to compensate him in kind for the loss, as the result of the secrecy order, of the twelve months' filing period under the Convention for the Protection of Industrial Property (*supra*, pp. 4, 7–8). Attached to the complaint was a letter of petitioner's patent attorney to the Atomic Energy Commission (R. 11–13) which stated (among other things) that he expected petitioner's American patent to issue within a few months and that this, by itself, would constitute a publication which would end the entire controversy. Thus, petitioner is merely seeking to be placed in the same position as if the secrecy order had not issued. Under the Convention, petitioner would have had twelve months (and no more) to file his foreign patent applications without being met by the objection of prior publication. The secrecy order was lifted on February 1, 1957. Since then, petitioner has been able to file patent applications abroad. By now, he has had nine months more than the time allowed to him under the Convention, and there is nothing to indicate that it has been more difficult than it was in 1950 (when secrecy was imposed) to finance and to arrange for the filing of applications abroad (cf. R. 6).

Petitioner, in short, has obtained far more than the protection he could have obtained under the Convention and almost twice the relief for which he asked when he filed his complaint. In any event, Article 4 of the Convention constitutes a finding, concurred in by most of the industrial nations, that twelve months

constitute an adequate period within which to file patent applications abroad. There appears to be no need to extend that term for petitioner alone.

(*b*). In addition to this general consideration, petitioner's statement that the issuance of the American patent was expected to occur within the next few months (*supra,* p. 17) amounted to an indication that the duration of the injunction, and the concomitant prejudice to the public, would be relatively short. As of this time, the restraint has lasted not a few months but nearly a year and a half. Moreover, petitioner has himself disclosed in his petition for certiorari that his patent application in this country has been allowed (Pet. 17). In these circumstances, petitioner appears to us to have lost all right to further equitable relief. It is now in his power to cause the patent to issue upon the payment of a moderate fee which probably does not amount to more than $30.00.[13]

Surely, petitioner would forfeit all right to equitable protection if he deliberately delayed the grant of the patent by taking full advantage of the six months period of 35 U. S. C. 151, or by attempting to use the additional period of a year provided by 37 C. F. R. 1.317. He who seeks equity must act diligently and must do equity. Procrastination in the payment of the patent fee, quite apart from keeping this litiga-

[13] 35 U. S. C. 41 (a) (2) provides that the fee on issuing a patent amounts to $30.00, and $1.00 for each claim in excess of twenty.

tion artificially alive, is contrary to the basic philosophy of the patent law.[14]

(*c*). A third weighty reason militates against the grant of specific equitable relief to petitioner. Respondents have learned of petitioner's invention not as the result of tort or of a breach of confidence, but from a report prepared by petitioner as a paid consultant for the very purpose of showing respondents how his improvements might be utilized in a dual temperature plant for the production of heavy water. (Pet. 16).

In these circumstances, the reservation by petitioner of his invention rights in the improved process does not entitle him to equitable relief if the effect of the reservation is to curtail the full utilization and publication by the United States of those parts of the process—far larger than petitioner's contribution to it—which are fully owned by respondents. In the circumstances of this case, knowing that his invention might be incorporated into a larger whole, petitioner must have limited his rights to monetary compensation and waived his rights to specific relief. Since the time of the Twelve Tables, it has been recognized that one may not tear down a house in order to replevy a beam, and that the owner of the latter may obtain only monetary compensation.[15]

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[14] And see in this context, *U. S. Gypsum Co.* v. *Nat. Gypsum Co.*, 352 U. S. 457, 465 and the authorities there cited.

[15] Poste, *Gaius* (Oxford, 1871), p. 171.

II

In the first part of this brief, we have shown that under general equitable principles petitioner is not now entitled to equitable relief, if indeed he ever was. We therefore suggest that the Court will never reach the broad and general question which petitioner raises, *i. e.*, whether respondents have authority to release information relating to an invention which does not belong to the United States. And if such an issue should be reached, we submit that the Court need not concern itself with the broad question posed by petitioner but only with the much narrower issue whether the Commission had authority to publish, in the special and particular circumstances of this case.

1. According to Section 3 of the Atomic Energy Act, 68 Stat. 922, 42 U. S. C. (Supp. V) 2013, it is the purpose of the statute to provide for "a program for the dissemination of unclassified scientific and technical information * * * so as to encourage scientific and industrial progress." We already have alluded to Section 141 (b) (*supra*, pp. 14–15) pursuant to which the Commission is to be guided by the principle that:

> The dissemination of scientific and technical information relating to atomic energy should be permitted and encouraged so as to provide that free interchange of ideas and criticism which is essential to scientific and industrial progress and public understanding and to enlarge the fund of technical information.

The only question here presented is whether, in the particular circumstances of this case, respondents'

power to disseminate information relating to atomic energy is limited precisely to the information owned by the United States, or whether and to what extent petitioner's invention rights may be disclosed together with admittedly public information. Petitioner and the *amici* set up a strawman, alleging that respondents claim the right to disclose every private invention right, including pending patent applications and reports made under Section 151 (c) of the Act (cf. *supra,* p. 13, fn. 12), and assert that, contrariwise, information relating to any private invention claims may not be released under any circumstances. That is not this case at all.

Our sole position in this case is that there are certain situations in which respondents are clearly authorized to publish invention rights not owned by the United States, and that this case falls within that class. Section 141 (b) (*supra,* p. 20) permits, and indeed requires, the publication of unclassified information relating to atomic energy belonging to the United States. Petitioner seems to take the position that this statutory policy of the Act is defeated whenever private invention rights are commingled with information belonging to the United States so that the one cannot be disclosed without revealing the other. But the Act provides no basis for such a destructive theory. Here, petitioner's invention constitutes only a small proportion of the entire information respondents seek to publish and is inseparable from that great mass of public information (*supra,* pp. 12, 14–15). If the Commission is not authorized to publish information

purportedly embodying petitioner's new process, it cannot disclose this large amount of significant data. Moreover, the process was disclosed to respondents by petitioner himself while he worked as a paid consultant for the Atomic Energy Commission, and it was understood that the Commission was to make use of the process (*supra*, pp. 3–4, 19). In these circumstances, the Act authorizes the publication of the technical aspects of heavy water production even if, incidentally, this disclosure should happen to include petitioner's process.

2. The disclosure of an invention *may*, of course, constitute a taking of private property. This, however, does not make the Atomic Energy Act unconstitutional. The Fifth Amendment does not require petitioner to be paid in advance of the taking. It suffices if Congress provides him with a reasonably just and prompt remedy and pledges, either expressly or by necessary implication, the public good faith to that end. *Crozier* v. *Krupp*, 224 U. S. 290, 306; *Hurley* v. *Kincaid*, 285 U. S. 95, 104; *Yearsley* v. *Ross Construction Co.*, 309 U. S. 18, 21. The many provisions of the Atomic Energy Act providing for just compensation,[16] are indicative of a congressional purpose to compensate every person whose property has been taken by the Atomic Energy Commission in the exercise of its statutory powers. Beyond that, 28

[16] See, *e. g.*, Section 43, 68 Stat. 929, 42 U. S. C. (Supp. V) 2063; Section 52, 68 Stat. 929, 42 U. S. C. (Supp. V) 2072; Section 66, 68 Stat. 933, 42 U. S. C. (Supp. V) 2096; Section 151 (a) (b), 68 Stat. 943, 42 U. S. C. (Supp. V) 2181 (a) (b); Section 157, 68 Stat. 947, 42 U. S. C. (Supp. V) 2187; Sections 171–173, 68 Stat. 952–953, 42 U. S. C. (Supp V) 2221–2223.

U. S. C. 1491 (2) confers upon the Court of Claims general jurisdiction to adjudicate claims based upon a taking of property by the United States. *Yearsley* v. *Ross Construction Co.*, 309 U. S. 18, 21; *United States* v. *Causby*, 328 U. S. 256, 267; *United States* v. *Dow*, 357 U. S. 17, 21. The availability of a remedy either directly under the Atomic Energy Act or under 28 U. S. C. 1491 (2), if there has been a taking, meets the constitutional requirements of a plain and adequate remedy. *Crozier* v. *Krupp, supra; Hurley* v. *Kincaid, supra; Yearsley* v. *Ross Construction Co., supra; Larson* v. *Domestic and Foreign Commerce Corp.*, 337 U. S. 682, 697, fn. 18.[17]

It is unnecessary to decide at this time whether or not petitioner can actually obtain an award. The court below has decided that disclosure by the Atomic Energy Commission is authorized by the statute in these circumstances. If petitioner should bring suit in the Court of Claims and that court should deny him a right to just compensation to which he is entitled, this Court will then be open to him at that time.

The result of applying these accepted principles to this case is that the Atomic Energy Commission will not be curtailed in its important function of dissemi-

[17] In the past, petitioner repeatedly has relied upon *In re Fulmer*, 86 U. S. P. Q. 116, a decision of the Atomic Energy Commission Patent Compensation Board, for the proposition that he would not be able to obtain compensation for losses occasioned by the publication of his invention. That decision, however, merely holds that under the Atomic Energy Act of 1946, the Patent Compensation Board had no jurisdiction to award damages for a disclosure. It has no bearing upon petitioner's rights under the 1954 Act and, in particular, not upon the availability of judicial relief.

nating significant information; this proves the wisdom of the general rule that "[t]he Government, as representative of the community as a whole, cannot be stopped in its tracks by any plaintiff who presents a disputed question of property or contract right". *Larson* v. *Domestic and Foreign Commerce Corp.*, 337 U. S. 682, 704. In this area, the citizen's remedy lies in the Court of Claims rather than before the chancellor.[18]

CONCLUSION

For the above reasons it is respectfully submitted that the petition for a writ of certiorari should be denied.

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[18] We also incorporate by reference our argument, set forth in detail in our brief in opposition in No. 641, October Term, 1957, pp. 12–13, to the effect that this case has become moot as the result of publication prior to the institution of the litigation.

APPENDIX

1. The Convention for the Protection of Industrial Property as Revised at London, June 2, 1934, provides in pertinent part, Article 4, 53 Stat. 1772:

> A. (1) Any person who has duly applied for a patent, the registration of a utility model, industrial design or model, or trade mark in one of the countries of the Union, or his legal representative or assignee, shall enjoy for the purposes of registration in other countries a right of priority during the periods hereinafter stated.
>
> (2) Any filing having the value of a formal national filing by virtue of the internal law of each country of the Union or of international treaties concluded among several countries of the Union shall be recognized as giving rise to a right of priority.
>
> B. Consequently, subsequent filing in one of the other countries of the Union before the expiration of these periods shall not be invalidated through any acts accomplished in the interval, as, for instance, by another filing, by publication of the invention or the working thereof, by the sale of copies of the design or model, or by use of the trade mark, and these facts cannot give rise to any right of third parties or any personal possession. The rights acquired by third parties before the day of the first application on which priority is based shall be reserved by the internal legislation of each country of the Union.
>
> C. (1) The above-mentioned periods of priority shall be 12 months for patents and utility models and 6 months for industrial designs and models and for trade marks.

(2) These periods shall start from the date of filing of the first application; the day of filing is not counted in this period.

(3) If the last day of the period is a legal holiday, or a day on which the Patent Office is not open to receive applications in the country where protection is claimed, the period shall be extended until the next working day.

* * * * *

2. The Atomic Energy Act of August 30, 1954, 68 Stat. 919, 42 U. S. C. (Supp. V) 2011 ff., provides in pertinent part:

Section 141, 68 Stat. 940, 42 U. S. C. (Supp. V) 2161:

It shall be the policy of the Commission to control the dissemination and declassification of Restricted Data in such a manner as to assure the common defense and security. Consistent with such policy, the Commission shall be guided by the following principles:

(a) Until effective and enforceable international safeguards against the use of atomic energy for destructive purposes have been established by an international arrangement, there shall be no exchange of Restricted Data with other nations except as authorized by section 144; and

(b) The dissemination of scientific and technical information relating to atomic energy should be permitted and encouraged so as to provide that free interchange of ideas and criticism which is essential to scientific and industrial progress and public understanding and to enlarge the fund of technical information.

Section 142, 68 Stat. 941, 42 U. S. C. (Supp. V) 2162:

(a) The Commission shall from time to time determine the data, within the definition of Restricted Data, which can be published without undue risk to the common defense and security

and shall thereupon cause such data to be declassified and removed from the category of Restricted Data.

(b) The Commission shall maintain a continuous review of Restricted Data and of any Classification Guides issued for the guidance of those in the atomic energy program with respect to the areas of Restricted Data which have been declassified in order to determine which information may be declassified and removed from the category of Restricted Data without undue risk to the common defense and security.

* * * * *

3. Title 35 of the United States Code (Patents) provides in pertinent part:

SECTION 122. Applications for patents shall be kept in confidence by the Patent Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner.

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